

**REMARKS/ARGUMENTS**

Applicant has amended claim 1 to recite the subject matter of claim 6. Applicant has added new claim 10, which is claim 8 rewritten in independent form. Claims 1 and 10 also recite the range disclosed on page 6, line 5 of the specification. Applicant also has deleted "suitable". Claims 11, 12 and 13 have been added to claim specific embodiments of the invention.

These amendments are not the addition of new matter. Accordingly, Applicant respectfully asks the Examiner to enter the amendments.

Applicant respectfully submits that deleting "suitable" from the claims alleviates the rejection under the second paragraph of 35 U.S.C. 112. Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection.

Applicant respectfully traverses the rejection of claims 1-3 and 6-9 under 35 U.S.C. 102 (b) over US 6,130,176 to Lam.

Claim 1 and the claims dependent thereon patentably distinguish over Lam in the recitation of:

a friction material comprising a fibrous base material having fiber content of about 75% to about 85%; and

wherein the fibrous base material comprises, from about 15 to about 25% cotton fibers, about 40 to about 50% aramid fibers and 10 to about 20% carbon fibers.

Nowhere does Lam disclose or suggest this combination.

Applicant respectfully submits that Lam teaches away from what Applicant claims. For column 8, line 58 to column 9, line 1 to teach

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Applicants invention, one would have to employ the maximum amount of fiber and the minimum amount of filler.

Note, column 9, lines 2 to 7 of Lam teaches at least 10% carbon particles and at least 25% filler. This embodiment can only employ no more than 65% fibers.

The only example in Lam teaches 55% fibers. See column 9, lines 14-20.

Clearly, Lam has no appreciation for the claimed combination.

Without Applicant's specification for a road map, one would not reach the claimed combination. The mere fact that the prior art may be so modified would not have made the modification obvious, unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Clearly, Lam suggests the desirability of less fibers and more filler.

Claim 10, likewise, is patentably distinct for the same reasoning.

Claims 2 and 11 are even more patentably distinct in reciting 80% fibers in combination with the claimed ranges.

Claims 12 and 13, likewise, are even more patentably distinct in reciting more than 80% fibers in combination with the claimed ranges.

The claimed invention is an elastic and porous friction material having a high amount of fibers. The friction material has high coefficient of friction characteristics, high-energy durability, and extremely high heat, or "hotspot" resistance. The friction material also has improved strength, wear resistance and noise resistance.

Applicant respectfully submits that the only source of support for the claimed features is his specification, not the Lam reference. See *In re Gal*, 980 F.2d 717, 25 USPQ 2<sup>nd</sup> 1076 (Fed. Cir. 1992).

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Accordingly, Applicant respectfully ask that the Examiner withdraw the rejections under 35 U.S.C. § 102.

Applicant respectfully traverse the rejection of claim 4 under 35 U.S.C. 103 (a) over US 6,130,176 to Lam in view of either Derwent Pub-no RD 406020 or US 6,013,696 to Hill et al.

The deficiencies of the Lam reference in rendering obvious the instant claims have been discussed above and, for the sake of brevity, will not be further repeated herein.

The Examiner argues that since the Lam reference is silent with respect to whether the fibrous base material is woven or non-woven, it is presumed that the detail was omitted with the understanding that it would be implicit to one of ordinary skill in the art that both woven and non-woven materials are included.

Applicant respectfully submits that the Examiner's position is unfounded. The conclusion goes beyond the teachings of the reference.

That the elements might be individually located in various prior art disclosures cannot automatically lead to a conclusion that the elements ought to be combined in the manner claimed without a showing of motivation in the art in support of the specific combination. *In re Wener Kotzab*, 55 USPQ2d 313, 317-318 (Fed. Cir. 2000).

Clearly, the numerous modifications required to sustain the rejection are beyond the teachings of the 3 references.

Accordingly, Applicant respectfully ask that the Examiner withdraw the rejections under 35 U.S.C. § 103.

Applicant also respectfully traverses the rejection of claim 5 under 35 U.S.C. 103 (b) over US6,130,176 to Lam in view of either US 4,997,067 to Watts or Us 5,495,922 to Booher.

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Accordingly, Applicant respectfully ask that the Examiner withdraw the rejections under 35 U.S.C. § 103.

Clearly, Applicant has provided a unique solution to a special problem. The friction material has a high amount of fibers in a fibrous base material such that the friction material is more elastic and porous than conventional friction materials.

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Therefore, Applicant respectfully submits that claims 1-5, 7 and 9-13 as amended are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,  
EMCH, SCHAFFER, SCHAUB  
& PORCELLO CO., L.P.A.

By: 

Patrick P. Pacella  
Reg. No. 25,463  
Tel.: (419) 243-1294